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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/667,408	09/21/2000	Charles E. Roos	A32398-PCT-USA-066355.011	8750
21003	7590	06/30/2004	EXAMINER	
BAKER & BOTTS 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			COSIMANO, EDWARD R	
			ART UNIT	PAPER NUMBER
			3629	
DATE MAILED: 06/30/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/667,408

Applicant(s)

ROOS, CHARLES E.

Examiner

Edward R. Cosimano

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My

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/21/00 & 4/23/04 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20040423.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. Applicant should note the changes to patent practice and procedure:
 - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;
 - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and
 - C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.
2. Applicant's claim for the benefit of an earlier filing data under 35 U.S.C. § 119(e) and 35 U.S.C. § 120 is acknowledged.
3. The proposed drawing correction filed April 23, 2004 has been approved.
4. The amendment filed April 23, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:
 - A) the added text to page 16 as amended April 23, 2004, where the italicized text is considered to be new matter see:
 - (1) the sentence "At step 650, computer 370 monitors the security of the sealed data port (e.g. sealing and/or network interface firewalls) for any breaches *and accordingly controls the flow of data through the data port, for example, for all of the concurrent or subsequent steps* shown in FIG. 6."; and
 - (2) the sentences "Computer 370 may include a processor or means 351 for detecting a satellite identified location of the personal medical alert device or other such device using, for examples network wireless transmission 361 which includes satellite communications. Compute 370 also may be configured to detect security breaches in sealed data ports (e.g. network interface 272, which is configured as a firewall) and accordingly *control transmission of data through the sealed data port interface.*".

Applicant is required to cancel the new matter in the reply to this Office Action.

5. The disclosure is objected to because of the following informalities:

A) as required by 37 CFR § 1.84(p(5)) and 37 CFR § 1.121(e) the specification lacks an explicit reference to the nature of:

(1) how the program proceeds after box(es):

(a) 635 of fig. 6 if the inquiry is "YES" in the context or the paragraphs at page 18, lines 23-29, "In addition, the bank 621has ... with potentially troublesome vendors."; and

(b) 630 of fig. 6 if the inquiry is "NO" in the context or the paragraphs at page 18, lines 23-29, "In addition, the bank 621has ... with potentially troublesome vendors.".

In this regard, it is noted that merely mentioning either a feature or a number with out mentioning the device or operation or number or feature relies on the drawing to provide support for the disclosure and not to aid in the understanding of the invention, as is the purpose of the drawings (37 CFR § 1.81(a,b)).

Appropriate correction is required.

6. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

7. Claims 1-21 are rejected under the judicially created doctrine of double patenting over claims 1-37 of U. S. Patent No. 5,699,276 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

7.1 The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

A) an utility meter unit; and

B) a computerized interface device for providing the exchange of data, video, voice/sound between an internal network and an external network.

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7.2 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

7.3 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

7.4 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR § 1.136(a).

8.1 A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. The following is an Examiner's Statement of Reasons for Allowance over the prior art:

A) the prior art, for example:

(1) Davis et al (5,898,387) discloses a meter box that includes an utility meter for measuring the amount of a utility consumed by a house and an area

external to the meter box to accept various network interface cards, so as to permit an external network to communicate with a network that internal to the house.

(2) Jarman et al (2003/0167178) discloses an external interface to perform secured transactions over the network.

B) in regard to claim 1, the prior art does not teach or suggest moving an external interface for interfacing various types of networks as taught by the prior art to a location within the enclosure of an electric meter box as recited in claim 1. Claims 2-21 are allowable for the same reason.

10. Response to applicant's arguments.

10.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

10.2 As per the remaining objection to the disclosure, since:

A) the description of fig. 6 between page 17, line 25 and page 18, line 29, as reproduced below clearly does not describe these features,

“Referring next to Fig. 6, a sixth embodiment of the present invention is illustrated, with the data port being used to facilitate secure banking and Internet transactions. As noted above, the data port may be used in connection with a home based input device, such as a television remote control, to enable communication between the electric company and the homeowner. Using a remote control, a wireless keyboard or other input devices (not shown) that are linked to a house electric lines 332, the present invention likewise permits a homeowner to conduct secure banking and Internet purchasing.

Fig. 6 is a flow diagram illustrating the steps of a method to conduct secure banking and Internet purchasing using the data ports. A purchaser 620 who wishes to conduct such business may use the data port, acting as a secure terminal 623, to contact his or her bank 621. When a home owner initiates a banking transaction, PC interface 398 will transmit only the data port serial number, and not an initial or public encryption key, to the appropriate bank or other financial institution via the

communications network 625. In turn, the bank would be the only institution, which has a look up table to associate the data port serial number with the initial or public key number. The bank, of course, will also have the private key required to ultimately decode the message. 114 this way, a thief would have to not only have to break to the private key to decrypt the financial transaction, but would also need to gain access to the serial number / public key table that is only held by the financial institution 621.

Returning to Fig 6, when a purchaser 620 transmits their credit or debit card information over the Internet 622 to a vendor 630 to make a purchase, the vendor will ordinarily contact the bank that issued the credit card 621 to verify the transaction. The bank then checks to determine whether the purchaser has sufficient funds to conduct the transaction 622. In accordance with the present invention, in order to verify that the purchase has originated from the homeowner's secure terminal 623 the bank can also send a query 625 to the home owner's data port 623. If sufficient funds are lacking 633, or the purchase authorization 634 was not on the secure terminal 623, the bank 621 notifies the vendor 630 that payment has been refused 640 and informs the purchaser 620 the reason that the bank 621 refused payment authorization 641.

In addition, the bank 621 has the option 635 to check if the vendor is not trustworthy, e.g., because it is a suspect company, or option 636 to check if vendor is not a domestic business subject to U S laws, in which event additional purchase authorization requirements may be imposed 632.

Only when all safeties are met will the bank 621 guarantee payment to the vendor 630 and the transaction consummated 631. In this way, the purchaser 620 is offered additional consumer protection to prevent transactions initiated by a third party has gained access to his or her credit card information or in dealings with potentially troublesome vendors.”.

Hence, applicant's arguments are non persuasive.

10.3 As per the obvious double patenting rejection, since:

A) the subject covered by the scope of each set of claims clearly overlaps the subject matter covered by the other set of claims and there fore would extend

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applicant's monopoly, whether or not there are any new features/limitation added to one set of claims does not change or affect a determination that there is overlapping subject matter;

B) applicant has not canceled the conflicting claims;

C) applicant has not amended the conflicting claims so that they no longer cover overlapping subject matter; and

D) applicant has not filed a terminal disclaimer.

Hence, applicant's arguments are non persuasive.


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

11.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

11.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

11.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

06/23/04


Edward R. Cosimano
Primary Examiner A.U. 3629